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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,147	06/14/2002	Mark A. Kappel	126065	3243

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EXAMINER

OMGBA, ESSAMA

ART UNIT	PAPER NUMBER
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3726

DATE MAILED: 07/16/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/064,147

Applicant(s)

KAPPEL ET AL.

Examiner

Essama Omgba

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 14-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-13, drawn to a tool for separating a first circuit board and a second circuit board, classified in class 29, subclass 764.
 - II. Claims 14-20, drawn to a method of disconnecting a first circuit board from a second circuit board, classified in class 29, subclass 426.6.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus such as one that does not require a piston assembly.
3. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mr. Kevin Mierzwa on July 7, 2003 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-13. Affirmation of this election must be made by applicant in replying to this

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Office action. Claims 14-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Specification

6. The disclosure is objected to because of the following informalities: "plain" in line 27 of page 10 should read --plane--; on page 11, lines 2, 8 and 9, reference numeral "192" is used to designate both a "channel" and a "stop": it is not clear whether the "channel" and the "stop" represent the same structure, if so then Applicant should make that clear in the specification or use different reference numerals for the "channel" and the "stop"; also in line 5 of page 11, "piston 188" should read --piston 172-- and in line 6 of the same page, "socket carrier 48" should read --socket carrier 72--.

7. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Applicant should change "handle 174" to --grip handle 174-- through out the specification in order to distinguish it from "handle 176" and provide proper antecedent basis for the claimed subject matter, the same applies to "handle 202" and "handle 208".

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Appropriate correction is required.

Claim Objections

8. Claims 1-13 are objected to because of the following informalities: in claim 1, lines 5 and 8, and in claim 11, line 11, "blade" should read --blades--; in claim 9, line 2 "block" should read --blocks--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 11, the term "normally" renders the claims indefinite because it is not readily clear what represents the "normal state".

Claims 9, 10 and 13 recite the limitations "said guide block" and "said block" in lines 1 and 2. There is insufficient antecedent basis for these limitations in the claims.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Greco (US Patent 4,215,468).

With regards to claim 1, Greco discloses a tool 10 for extracting a circuit board, the tool comprising a piston assembly 11, a handle 33 and first and second blades 20 coupled between the handle and the piston assembly, the first and second blades normally biased outwardly, see figures 1 and 6, the handle having a first position and a second position relative to the piston assembly, in the first position the blades being biased outwardly, see figures 1 and 6, and in the second position the piston assembly biasing the blades inwardly to engage the circuit board, see figures 2 and 3. Applicant should note that the tool of Greco is capable of separating a first circuit board from a second circuit board.

For claim 2, see grip handle 40.

For claim 3, see first spring 47.

For claims 4 and 5, see second spring 41 and figure 6.

For claims 6 and 7, see channel 18 and figures 4 and 5.

13. Claims 1, 2, 4, and 8-13 are rejected under 35 U.S.C. 102(b) as being anticipated by McDevitt et al. (US Patent 4,583,287).

With regards to claims 1, 2, and 11, McDevitt et al. discloses a tool for extracting a circuit board, the tool comprising a piston 28 having a first end and a second end, the first end having a grip handle 30 thereon, a handle 20 slidably received on the piston, a block 14, compression means 12 fixedly coupled to the block and the second end of the

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piston, a first blade and a second blade 32 fixedly coupled to the handle so that the blades are positioned between the compression means and the block, the blades normally biased outwardly, see figures 3 and 4b, the handle having a first position and a second position relative to the block, in the first position, the blades being biased outwardly and in the second position the blades being biased inwardly to engage the circuit board, see column 4, lines 22-36 and figures 3, 4b and 5a. Applicant should note that the tool of McDevitt et al. is capable of separating a first circuit board from a second circuit board.

For claims 4 and 12, see spring in figure 2.

For claim 8-10, se guide block 14 and blocks and compression member 12 in figure 2.

For claim 13, see column 4, lines 22-36.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Essama Omgba whose telephone number is (703) 305-2915. The examiner can normally be reached on M-F (10-7:30) First Friday off.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on (703) 308-1513. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703) 305-3579 for regular communications and (703) 305-3580 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

eo 
July 9, 2003


GREGORY VIDOVIK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700